

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Carlos del Pozo Losada et al.

Group Art Unit: 1625

Serial No.: 10/523,172

Examiner: Solola, Taofiq A.

Filed: September 1, 2005

Confirmation: 6504

For: Total Synthesis of Myriaporones

**REQUEST FOR RECONSIDERATION OF USPTO DECISION
REGARDING CORRECTION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This letter is to request reconsideration of the USPTO decision of March 17, 2009, which held in abeyance the previous request for correction of Patent Term Adjustment Under Rule 705(b), submitted on February 19, 2009. A copy of the March 17, 2009, USPTO decision is attached. The reason for holding the decision in abeyance was that the patent had not issued, and the issue date would be required to make an accurate determination of the patent term adjustment, if any, to which the Patentee would be entitled. The patent for the application issued on April 21, 2009, as U.S. Patent 7,521,478. Therefore, Patentees respectfully request reconsideration of the previous USPTO decision.

For the convenience of the USPTO, the facts as set forth in the February 19, 2009 request are set forth again below. The \$200 fee required by Rule 18(c) was authorized in the original request of February 19, 2009, and according to the USPTO Decision of March 17, 2009, the fee does not need to be paid again for this request for reconsideration. This patent is not subject to a terminal disclaimer.

Pursuant to Rule 703(b), the Office is to grant a patent term adjustment for the number of days that exceeds 36 months from the filing date of the application to the issue date of the application, excluding

- 1) the period following the filing of an RCE,
- 2) (i) following the declaration of an interference,
(ii) the period of suspension of prosecution due to an interference,
- 3) the period the application is under seal, and
- 4) the period of appeal.

Where a notice of appeal is filed, the period of adjustment under this paragraph “restarts” upon the mailing of a notice of allowance (See Rule 703(b)(4)). The calculation of periods for Patent Term Adjustment follows.

Calculation of Periods for Patent Term Adjustment

Under Rule 703(a)

Applicants agree with the USPTO determination that the PTO incurred 343 days delay under 703(a) for the period beginning November 1, 2006 (i.e., 14 months from the September 1, 2005 completion of the requirements under 35 USC § 371) until the mailing of a Restriction Requirement on October 10, 2007.

Under Rule 703(b)

The filing requirements under 35 USC § 371 were completed September 1, 2005, and the period exceeding 36 months ran from September 1, 2008 until the issue date of April 21, 2009. This period is 232 days.

Reduction Under Rule 704

The USPTO has found 14 days of Applicant delay.

Period of Patent Term Adjustment

The period for patent term adjustment should be the sum of non-overlapping days under Rules 703(a) and 703(b) minus the days of Applicant delay.

In Form PTOL-85, mailed November 26, 2008, the USPTO calculated that the Applicants are entitled to 329 days of patent term adjustment. In the "Patent Term Adjustment" tab in the official image file wrapper (Private-PAIR) for this application, the USPTO does not include a value for the USPTO's delay under Rule 703(b).

The correct calculation of patent term adjustment should include a value for Rule 703(b). Applicants believe that in this case the delays under Rules 703(a) and 703(b) are not overlapping. Specifically, the USPTO delay under Rule 703(a) occurred from November 1, 2006 until October 10, 2007, while the USPTO delay under Rule 703(b) occurred from September 1, 2008 until April 21, 2009. These periods do not overlap (see *Wyeth v Dudas* (D.D.C. 2008)).

Therefore, Applicants are entitled to the sum of 703(a) delay (343 days) plus 703(b) delay (232 days) minus the period of Applicant delay (14 days).

Summary of Requested Correction to PTA

The patent term adjustment of 329 days according to USPTO Form PTOL-85, mailed November 26, 2008, is incorrect because it does not include delays under Rule 703(b), as calculated above according to the plain language of the statute.

Applicants request that the patent term adjustment be corrected to add the USPTO delay under Rule 703(b) for a total of 561 days.

AUTHORIZATION

The Commissioner is hereby authorized to charge the fee set forth in 37 C.F.R. § 1.18(e) to Deposit Account No. **50-3732**, Order No. 13566.105013. The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this communication to Deposit Account No. **50-3732**, Order No. 13566.105013. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **50-3732**, Order No. 13566.105013.

Respectfully submitted,
King & Spalding, LLP

Dated: May 20, 2009

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OFFICE OF PETITIONS

In re Application of :
Losada et al. :
Application No. 10/523,172 : ON APPLICATION FOR
Filed: September 1, 2005 : PATENT TERM ADJUSTMENT
Atty Docket No. 13566.105013 :

This is in response to the PETITION FOR CORRECTION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) filed February 19, 2009. Applicants request that the patent term adjustment of three hundred twenty-nine (329) days be corrected to add the USPTO delay under Rule 703(b).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date¹, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

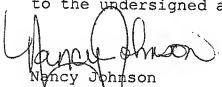
¹ or within 3 years of the date the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application will be forwarded to the Office of Data Management for issuance of the patent. The revised patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Patents Attorney
Office of Petitions